

Doc. No.: 2001 P 13459 US
App. No.: 09/917,373

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REMARKS

Claims 13 and 16-21 are pending in the Application. Claims 13 and 19 have been amended. Claim 21 has been added; however, no additional claims fees are necessary.

Claim Rejections - 35 U.S.C. § 102

The Patent Office rejected claims 13 and 18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication 2002/0197961 by Warren, ("Warren").

Applicant respectfully traverses. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). Emphasis added.

Applicant respectfully submits claim 13 recites elements which have not been disclosed, taught or suggested by Warren. For example, claim 13 generally recites a concealed telephone system which includes a telephone and a pair of glasses whereby a switch is integrated within the sidepiece of the glasses for activating a function of the telephone. Emphasis added. The switch of the present application may allow controlling of a telephone in a discreet and inconspicuous manner. Warren fails to disclose, teach or suggest a concealed telephone system which includes a telephone and a pair of glasses whereby a switch is integrated within the sidepiece of the glasses for activating a function of the telephone. The telephone system of Warren requires user input with the telephone to control telephone functions. Consequently, elements of claim 13 have not been disclosed, taught or suggested by Warren. Under *Lindemann*, a *prima facie* case of anticipation has not

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been established for claim 13. Claim 13 should be allowed. Claim 18 should be allowed due to its dependence upon claim 13.

Claim Rejections - 35 U.S.C. § 103

The Patent Office rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication 2002/0197961 by Warren, ("Warren") in view of Germany Patent DE 29715288U1 by Kirner, ("Kirner").

It is contended that all of the claims rejected under this section depend on independent claim 13, which is non-anticipatory and non-obvious based on the rationale above. Thus, dependent claim 16 (which depends on independent claim 13) should be allowed.

The Patent Office rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication 2002/0197961 by Warren, ("Warren") in view of U.S. Patent No. 6,438,245 by Taenzer et al., ("Taenzer").

It is contended that all of the claims rejected under this section depend on independent claim 13, which is non-anticipatory and non-obvious based on the rationale above. Thus, dependent claim 17 (which depends on independent claim 13) should be allowed.

The Patent Office rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication 2002/0197961 by Warren, ("Warren") in view of Japan Patent JP408079875A to Saka Shinji ("Shinji") in further view of Germany Patent DE 29715288U1 by Kirner, ("Kirner").

Applicant respectfully traverses. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Applicant respectfully submits claim 19 recites novel

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and nonobvious elements which have not been disclosed, taught or suggested by Warren, Shinji or Kimer, individually or in combination.

For example, Claim 19 generally recites a concealed telephony system including a telephone (12, 52) which includes a keyboard and display that can make and receive telephone calls; a earring; a bracelet; an earpiece (14, 54) that provides audio signals from the telephone to an ear of a user, the earpiece being integrated within the earring wherein the earpiece creates at least one of a tone or vibration when a telephone call has been received by the telephone. Emphasis added. The earpiece of the present application provides a discreet and inconspicuous alert when a call has been received by the telephone. Warren, Shinji or Kimer fails to disclose, teach or suggest earpiece being integrated within the earring wherein the earpiece creates at least one of a tone or vibration when a telephone call has been received by the telephone. Consequently, under *in re Ryoka*, a *prima facie* case of obviousness has not been established for claim 19. Claim 19 should be allowed.

The Patent Office rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication 2002/0197961 by Warren, ("Warren") in view of Japan Patent JP408079875A to Saka Shinji ("Shinji") in view of Germany Patent DE 29715288U1 by Kirner, ("Kirner") in further view of U.S. Patent No. 6,438,245 by Taenzer et al., ("Taenzer").

It is contended that all of the claims rejected under this section depend on independent claim 19, which is non-anticipatory and non-obvious based on the rationale above. Thus, dependent claim 20 (which depends on independent claim 19) should be allowed.

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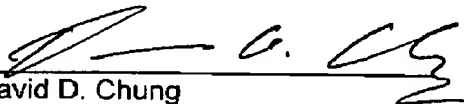
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Conclusion

Applicants respectfully submit that all claims are allowable, and it is respectfully requested that the entire application now be passed to formal allowance.

Respectfully Submitted,

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